

Remarks

Applicants greatly appreciate the recognition of patentable subject matter in the present application.

Applicants hereby add claims 29-35. Accordingly, claims 1-4, 6-11, 14-16, 18-21, and 23-35 are pending in the present application.

Claims 1-4, 6-7, 9-11, 14-16, 18-20, 23-24, and 26 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,641,244 to Dougherty et al. Claims 8, 21, and 25 stand rejected under 35 USC 103(a) for obviousness over Dougherty in view of U. S. Patent No. 5,148,218 to Nakane et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the rejection of claim 1 over Dougherty, Applicants note that the Examiner relies upon the theory of inherency in support of the rejection. The reliance is misplaced. More specifically, in relying upon the theory of inherency, the Examiner ***must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.*** *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). No basis in fact or technical reasoning has been provided (and none exists) and the rejection of claim 1 is improper for at least this reason.

The Office Action states on page 2 that the printer's process may be performed utilizing previously measured environmental conditions and it is alleged that this inherently shows that there is a history of measured environmental conditions (ECs) so that a process of the printer can be performed using the stored ECs. The reasoning is flawed for at least the following reasons and in view of the above-authority.

The teachings of Dougherty relied upon in col. 6, lines 5-10 merely state that the process may be performed using previously measured ECs. It is clear from the teachings of col. 5, lines 10-16 that the previously stored value corresponds to the ***most recent measurement*** of the ECs to provide accurate printing using the most up to date data. Indeed, it is stated that the value is ***updated***. In col. 5, lines 3-5 it is stated that ECs are used immediately before printing or during printing. There is absolutely no teaching or suggestion of storage of a plurality of values of an EC

providing a history.

In view of the express teachings of Dougherty, Dougherty is concerned with using *real time* ECs during printing operations. There is no teaching or suggestion in Dougherty to utilize a history of ECs and the explicitly disclosed process of Dougherty is not concerned with a history. As a result, the interpretation of the Dougherty teachings can only result from the Examiner inasmuch as a history is of no use or concern to Dougherty. In fact, the updating and usage of the most recent EC teaches replacement of old EC values. Regardless, at a minimum, Dougherty does not disclose or suggest a history. *In relying upon inherency, the allegedly inherent limitations must necessarily flow from the teachings of the reference.* However, as is evident from the above, not only does the claimed history not necessarily flow from the teachings of Dougherty, the reference suggests going in the opposite direction of a history by updating a value to provide the most current EC value for use in real time printing. The reliance upon inherency is improper for at least the above-mentioned reasons. The prior art fails to disclose or suggest positively-recited limitations of claim 1 and claim 1 is allowable for at least this reason.

In the event that a rejection of claim 1 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as

well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 2, it is positively-recited that the interface configured to communicate the data comprises a memory of the consumable. Dougherty is devoid of any details regarding *memory of a consumable* let alone the memory of the consumable configured to communicate the data indicative of the at least one environmental condition as claimed. Memory 125 is not disclosed as being part of a consumable but to the contrary is disclosed at col. 3, lines 32-45 as being core hardware to the printer including software for control of controller 120. It is nonsensical to interpret core programming of the printer as being stored within memory of a consumable. Dougherty fails to disclose or suggest limitations of claim 2 and claim 2 is allowable for at least this reason.

Contrary to the above-recited CFR section, absolutely no teachings of Dougherty have been identified in the Office Action as allegedly corresponding to the claimed memory of the consumable. In accordance with the CFR section, Applicants respectfully request clarification of any rejection of claim 2 in a non-final Action so Applicants may appropriately respond if claim 2 is not allowed.

Referring to the obviousness rejection of claims 8 and 25, Applicants refer to page 4 of the Action which states that Dougherty qualifies as art under 102(e). As noted, the applied reference has a common assignee with the instant application. Pursuant to 35 USC 103(c), Dougherty may not be properly asserted in an obviousness rejection. Applicants request allowance of claims 8 and 25 or the issuance of a non-final Action to correct the deficiencies of the present Action so Applicants may appropriately respond.

Referring to new claim 29, it is recited that the interface is configured to output the history externally of the image forming device. Dougherty is concerned with real time print quality and receives ECs to modify a current print process. Dougherty is devoid of disclosing outputting of the history as claimed. Dougherty may not be fairly interpreted as disclosing the claimed outputting in view of Dougherty's internal real time usage of the ECs. Claim 29 is allowable.

Referring to the rejection of claim 11, it is stated on page 3 of the Action that the teachings in cols. 3-4 of Dougherty allegedly disclose the claimed receiving of the request. Applicants disagree.

More specifically, the disclosed actions of Dougherty at cols. 3-4 including the polling actions of the controller and downloading information from a web site with respect to obtaining EC information from externally of the printer for use internally of the printer provide absolutely no teaching or suggestion of the claimed receiving of the request within the image forming device and the communicating data regarding the at least one environmental condition externally of the image forming device responsive to the receiving. Dougherty discloses the printer outputting requests (i.e., polling or requesting a web page) to receive ECs and such fails to disclose or suggest the claimed receiving of the request within the device and the communication responsive thereto as claimed. Positively-recited limitations of claim 11 including the receiving are not taught nor suggested by the prior art and claim 11 is allowable for at least this reason.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 16, the Office Action is devoid of identifying any prior art teachings which allegedly disclose the claimed receiving data regarding at least one environmental condition from the image forming device. Dougherty is replete with teachings regarding reception of ECs within the printer but fails to disclose any teachings regarding outputting of an EC from the printer or receiving an EC from the printer. Further, such an interpretation is non-sensical in view of the teachings of Dougherty regarding internal usage of ECs for implementing internal real time printing processes. Positively-recited limitations of claim 16 are not shown nor suggested by the prior art and claim 16 is allowable for at least this reason. Applicants respectfully request a non-final Action to identify the prior art teachings relied upon pursuant to the CFR if claim 16 is not allowed so Applicants may appropriately respond.

The claims which depend from independent claim 16 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, the 103 rejection is improper pursuant to 35 CFR

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103(c). Applicants respectfully request allowance of claim 21 or the issuance of a non-final Action to cure the deficiencies of the present Action and so Applicants may appropriately respond.

Referring to claim 23, the prior art fails to disclose or suggest any teachings with respect to a *consumable comprising memory or communication of data indicative of at least one environmental condition externally of the image forming device using the memory of the consumable* as positively recited in claim 23. Positively-recited limitations of claim 23 are not taught nor suggested by the prior art and claim 23 is allowable for at least this reason. In the event that claim 23 is not allowed in the next Action, Applicants respectfully request issuance of a non-final Action so Applicants may appropriately respond.


Applicants hereby add new claims 29-35 which are supported at least by Figs. 2-3 and the associated specification teachings of the originally-filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Srinivas Guddanti
Chet Butikofer

By:



James D. Shaurette
Reg. No. 39,833
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